



IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Attorney Docket No.: **Bell-17 (00-VE02.64)**

Appl. No.: **09/487,049**

Applicants: **Mohammad Reza SHAFIEE, Sankar SUBRAMANIAN**

Filed: **January 19, 2000**

Title: **METHODS AND APPARATUS FOR PROVIDING AGENT CONTROLLED
SYNCHRONIZED BROWSING AT A TERMINAL**

TC/A.U.: **3621**

Examiner: **John W. Hayes**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

REPLY BRIEF

Further to the Examiner's Answer (Paper No. 21), mailed on March 24, 2004, which set a period of response to expire on May 24, 2004, the applicants request that the Board further consider this Reply Brief.

Argument

The arguments made by the applicant in the Appeal Brief are maintained and incorporated herein by reference. This Reply Brief is intended to supplement, not replace, the Appeal Brief.

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Status of Amendments

In the Appeal Brief, the applicants indicated that no amendments were filed subsequent to the final Office Action mailed on June 23, 2003 (Paper No. 12). In the Examiner's Answer, the Examiner indicated that this was incorrect because a Request for Reconsideration (Paper No. 14) was filed after the final Office Action but not entered. (See Paper No. 21, page 2.) Applicants believe that their statement in the Appeal Brief was correct since the Request for Reconsideration did not seek to amend the application. In any event, applicants believe that whether or not the Request for Reconsideration is characterized as an amendment, the Board's decision should not be procedurally or substantively impacted.

Grouping of Claims

The Examiner did not agree with the applicants' statement that certain claims do not stand or fall together. Specifically, the Examiner argued that the applicants did not provide a separate reason as to why the claims in Group VIII do not stand or fall together and believes that this group should be abolished, with the claims of this group being incorporated into Group IV. (See Paper No. 21, page 2.) Applicants respectfully disagree.

Specifically, the Appeal Brief stated:

Group VIII: Claims 27 and 38 are separately grouped with claim 27 being selected as the single claim from the group upon which the appealed ground of rejection should be decided. **These claims are subject to a different rejection than those of Groups I-VI.** Although the claims of Group VIII are subject to the same rejection as the claims of Group VII, **these claims are separately patentable because representative claim 27 further recites that whether access to content associated with the browsing command is permitted is determined by (i) determining whether or not the browsing command includes a resource locator that has a NO GO status based on at least one of first rules regarding resource locators and a first list of resource locators, (ii) if it is determined that the browsing command includes a resource locator that has a NO GO status, then (A)**

setting a status to NO GO, (B) determining whether or not the browsing command includes a resource locator that has a GO status based on at least one of second rules regarding resource locators and a second list of resource locators, and (C) if it is determined that the browsing command includes a resource locator that has a GO status, then setting the status to GO, and (iii) requesting the content associated with the browsing command if the status is GO. Accordingly, claims 27 and 38 stand together. [Emphasis added.]

The fact that the Examiner separately rejected the claims of Group VIII and the claims of Group IV evidences that they are separately patentable. Moreover, the dependencies of the claims of Groups IV and VIII are different. Consequently, one set of claims pertains to a guide terminal while the other pertains to a follower terminal. In addition, the claims of Group VIII are separately patentable over the claims of Group VII since representative claim 27 includes the highlighted recitation reprinted above, which does not appear in claims of Group VII and which is neither taught, nor suggested, by the cited art.

In view of the foregoing, the applicants respectfully submit that the claims of Group VIII should be considered separately.

Argument

The arguments in the Appeal Brief are incorporated herein by reference in their entirety.

Group I: Claims 1, 2, 5-10, and 28

In the “Response to Argument” section presented in the Examiner’s Answer, the Examiner stated that he:

disagrees with the notion that the security measures offered by Kannan are limited to securing personal information, such as questions, personal data, and credit card information, needed “to complete a commercial transaction”

and stated:

this is but one reason or example, among many, for implementing a secure protocol such as SSL between two parties over the Internet, but does not in any way limit the teachings of Kannan to only these scenarios. Kannan specifically discloses that the invention provides secure customer service over the Web using Web-based security techniques and one preferred example includes providing security for each of the communications over links 500 and 501 through the user of a Secure Socket Layer (SSL)(0129).

Paper No. 21, page 11. The problem with this argument is that the “but one reason or example” for implementing SSL *is the only one taught or suggested* by the Kannan application. The Examiner does not substantiate where he believes the other examples alluded to are taught or suggested in the Kannan publication. Further, paragraph [0129] of the Kannan publication cited by the Examiner as teaching using SSL for all communications over links 500 and 501 actually reads:

In one preferred example, security for each of the communications over links 500 and 501 **described above according to the present invention** is provided through a secure socket layer (SSL). [Emphasis added.]

The Examiner is attempting to extend the Kannan application beyond what it actually teaches or suggests. Applicants respectfully submit that the Board should consider the features actually taught by the Kannan publication, not mere possibilities alluded to by the Examiner.

The arguments in the Appeal Brief to Group I are incorporated herein by reference in their entirety.

Group II: Claims 40 and 42

In the “Response to Argument” section presented in the Examiner’s Answer, the Examiner stated that:

although Goss and Kannan use Java applets for functionality, the reference to Kannan specifically teaches that the invention is not intended to be limited to Java or Java enabled browsers, and can be implemented in any programming language and browser, developed now or in the future, as would be apparent to a person skilled in the art.

Paper No. 21, page 12. Even if the Kannan patent can use something other than Java or Java enabled browsers, it still relies on applets of one form or another. Moreover, legal boilerplate about the scope of the invention in the Kannan application should not be used to expand what it would have suggested to one skilled in the art *at the time of the invention* beyond any enabling disclosure, particularly when such boilerplate discusses “future” developments.

The Examiner further argues that one skilled in the art would be interested in avoiding the downloading and/or execution of applets in environments where security is an issue. However, the applicants respectfully submit that one skilled in the art would not have been motivated to disable applets where doing so would destroy the functionality of the devices described in the references!

Finally, the Examiner argues that the claim language is such that the prior art need only teach disabling the downloading of applets or disabling the execution of applets, but not both. (See Paper No. 21, page 12.) Even assuming, arguendo, that the Examiner is properly interpreting the claim language, this does not excuse his failure to find either teaching.

The arguments in the Appeal Brief to Group II are incorporated herein by reference in their entirety.

Group III: Claims 3, 4, 29, and 30

In the “Response to Argument” section presented in the Examiner’s Answer, the Examiner stated that the applicants were apparently arguing that the Camaisa patent is non-analogous art, and cited *In re Oetiker* as holding that the prior art reference must be either be in the field of the applicant’s endeavor or, if not, then reasonably pertinent to the particular problem with which the applicant was concerned, to be relied on as a basis for

rejection. (See Paper No. 21, page 13.) Applicants respectfully note that *In re Oetiker* sets a floor -- a minimum requirement -- for a prior art reference. However, merely meeting this minimum requirement does not mean that the Examiner has shown that the Camaisa patent would have suggested the modification proposed by the Examiner to one skilled in the art. To reiterate the argument set forth in the Appeal Brief, restricting a user's access may be a legitimate concern in a system such as the Camaisa patent where the "particular problem" being addressed is unguided browsing. However, this does not suggest restricting access in a system where a **guide terminal leads** a synchronized browsing session as in the Goss patent.

The arguments in the Appeal Brief to Group III are incorporated herein by reference in their entirety.

Group IV: Claim 39

In the "Response to Argument" section presented in the Examiner's Answer, the Examiner argues that claim 39 simply recites setting a status to NO GO when the browsing command includes a resource locator that has a NO GO status based on first rules and setting the status to GO when the browsing command includes a resource locator that has a GO status based on second rules. (See Paper No. 21, page 14.) Applicants respectfully disagree with the Examiner's interpretation of claim 39 and invites the Board to consider the actual language which recites:

- (i) determining whether or not a browsing command includes a resource locator that has a NO GO status based on at least one of first rules regarding resource locators and a first list of resource locators, and
- (ii) ***if it is determined that the browsing command includes a resource locator that has a NO GO status, then***
 - (a) setting a status to NO GO,
 - (b) determining whether or not the browsing command includes a resource locator that has a GO status based on at least one of second rules regarding resource locators and a second list of resource locators, and

(c) if it is determined that the browsing command includes a resource locator that has a GO status, then setting the status to GO. [Emphasis added.]

Clearly, the Examiner is ignoring claim recitations – recitations that patentably define claims of this group over the prior art.

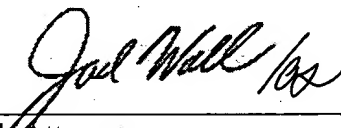
The arguments in the Appeal Brief to Group IV are incorporated herein by reference in their entirety.

Conclusion

In view of the foregoing, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants respectfully request that the Board reverse each of the outstanding grounds of rejection.

Respectfully submitted,

May 28, 2004



Joel Wall, Attorney
Reg. No. 25,648
Tel.: (972) 718-4800

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patents and Trademark Office on the date shown below.

Christian Andersen

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Signature

May 28, 2004

Date